

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the specification because the status of the parent application referenced in the first paragraph of the specification needs to be updated. In response, the specification has been amended to indicate that U.S. Application No. 09/931,847 has issued as U.S. Patent No. 6,736,772. Accordingly, it is respectfully requested that the objection to the specification be withdrawn.

In the Official Action, the Examiner objects to claim 14 because “the atmospheric pressure” should be --atmospheric pressure--. In response, claim 14 has been amended as discussed below in which the objectionable term has been removed. Accordingly, it is respectfully requested that the objection to claim 14 be withdrawn.

In the Official Action, the Examiner rejects claim 14 under 35 U.S.C. 112, second paragraph, because “the surface” and “the housing” lack antecedent basis. In response, claim 14 has been amended as discussed below in which the objectionable terms have been removed. Accordingly, it is respectfully requested that the rejection of claim 14 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 14-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,547,721 to Higuma et al., (hereinafter “Higuma”). Additionally, the Examiner rejects claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Higuma.

In response, independent claim 14 has been amended to clarify its distinguishing features.

Specifically, claim 14 has been amended to clarify to recite:

an elongate flexible tube having a distal end and a proximal end;

a cylindrical elastic member having a distal end and a proximal end and having an inner space formed to communicate from the distal end to the proximal end, the elastic member being arranged such that the flexible tube is inserted in the inner space; and

a seal portion provided to seal the inner space at the distal end side of the elastic member, the seal portion being engaged with the periphery of the flexible tube in order to keep the flexible tube fluid-tight,

wherein the seal portion separates from at least a portion of the periphery of the flexible tube in response to a predetermined pressure from the inner space side of the elastic member to release the fluid-tight connection.

The amendment to claim 14 is fully supported in the original disclosure, particularly at Figures 5A and 5B and the accompanying text of the specification. Thus, no new matter has been entered into the disclosure by way of the amendment to claim 14. Claim 16 has been amended to be consistent with amended claim 14.

The separation of the seal portion from the surface of the flexible tube acts as a check valve, thereby making it possible to adjust the inner pressure and the outer pressure of the endoscope without adding any member to the conventional structure of the endoscope.

In stark contrast, Higuma discloses a separate mechanism corresponding to the structure of a check valve (24). Higuma does not disclose or suggest an endoscope having a seal portion provided at the distal end side of an elastic member, wherein the seal portion separates from at least a portion of a periphery of a flexible tube in response to a

predetermined pressure from the inner space side of the elastic member to release the fluid-tight connection.

With regard to the rejection of claims 14-16 under 35 U.S.C. § 102(e), an endoscope having the features discussed above and as recited in independent claim 14, is nowhere disclosed in Higuma. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 14 is not anticipated by Higuma. Accordingly, independent claim 14 patentably distinguishes over Higuma and is allowable. Claims 15 and 16 being dependent upon claim 14 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 14-16 under 35 U.S.C. § 102(e).

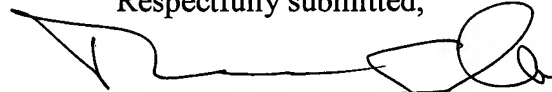
With regard to the rejection of claim 17 under 35 U.S.C. § 103(a), since independent claim 14 patentably distinguishes over the prior art and is allowable, claim 17 is at least allowable therewith because it depends from an allowable base claim.

Furthermore, new claim 18 has been added to further define the patentable invention. New claim 18 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 18. Applicants respectfully submit that new claim 18 is at least allowable as depending upon an allowable base claim (14).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a large, stylized flourish at the end.

Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm